

REMARKS

This amendment is submitted in response to the Final Office Action mailed August 29, 2007 ("Office Action"). Claims 14-17 and 20-22 are pending. Claim 14 is independent. In the Office Action, the Examiner:

- rejected claims 14-15, 17, and 20-22 under 35 U.S.C. § 102(b) ("Section 102(b)") as anticipated by U.S. Pat. No. 4,417,576 to Baran ("Baran"); and
- rejected claim 16 under Section 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) ("Section 103(a)") as obvious over Baran.

Claim 14 has been amended to recite a "reservoir space." Support for this amendment is found at page 6, lines 10-26 and figures 2A-2B of the specification as filed. No new matter has been added.

Rejections Under Section 102(b)

Claims 14-15, 17, and 20-22 are rejected under Section 102(b) as anticipated by Baran. Applicant respectfully requests that this rejection be withdrawn.

Independent claim 14 recites a catheter having an expandable portion comprising "a balloon having an outer surface," "a membrane . . . [comprising] an outer surface and an inner surface," and "a reservoir space disposed between the outer surface of the balloon[] and the inner surface of the membrane . . .[,] wherein the reservoir space is connected to a reservoir lumen for filling the reservoir space with biologically active material." Applicants respectfully submit that Baran does not disclose, teach, or suggest a reservoir space.

Assuming only for the sake of argument that the Examiner correctly identified reference letter U of Baran to be a membrane and reference letter E to be a balloon, Applicants respectfully disagree that Baran discloses a "reservoir/space between the outer surface of the balloon [E] and the inner surface of the membrane [U]." (Office Action at 2.)

More specifically, Baran does not disclose or suggest that there is any space at all between the outer surface of internal cuff E and the inner surface of sponge-like material U; elements E and U directly abut or contact each other. (*See, e.g.,* Fig. 3.) In fact, Baran states that "the space between internal cuff E and external cuff D [is] occupied by the sponge-like material U." (Col. 3, lines 8-12.) That this space is occupied by the material further shows that Baran does not include a reservoir space between the sponge-like material U and the

internal cuff E. Thus, Baran fails to disclose or suggest the recited reservoir space of the pending claims.

Applicants previously argued that Baran failed to disclose or suggest the recited reservoir in their Amendment dated May 21, 2007 submitted in response to Examiner's office action dated February 27, 2007. In response, the Examiner stated that the "reservoir happens to be filled with the membrane." (Office Action at 4.) Claim 14 now recites a "reservoir space," and therefore the Examiner's argument can no longer apply. Nonetheless, this argument fails, because it assumes that the reservoir space is disposed between (1) what the Examiner apparently regards as the outer surface of internal cuff E, and (2) what the Examiner apparently regards as the *outer* surface of "membrane" U, *i.e.*, the surface of sponge-like material U farther from internal cuff E. However, the claims recite "a reservoir space disposed between the outer surface of the balloon, and the *inner surface* of the membrane." (Emphasis added.) If a reservoir space were present in Baran's device, it *cannot* be filled with "membrane" U, because then the reservoir space would not be defined by the "*inner surface*" of the membrane. Therefore, even under the Examiner's interpretation, Baran still would not disclose or suggest this recitation. Thus, Applicants still respectfully submit that Baran still does not disclose, teach, or suggest a reservoir space.

Additionally, independent claim 14 discloses a "sponge coating . . . exposed to the body lumen . . . [and] having a plurality of voids[,] . . . wherein biologically active material can . . . enter the voids." Baran does not disclose, teach, or suggest a sponge coating exposed to the body lumen. Instead, the outer surface of the device of Baran is external cuff D. External cuff D cannot be a sponge coating, because according to Baran it must be rigid enough so that distending internal cuff E will compress sponge-like material U against external cuff D such that there is a uniform coat of anesthetic H about external cuff D. (Col. 2, lines 23-27; col. 3, lines 16-27.) Also, external cuff D cannot be a sponge coating, because it then would be part of sponge-like material U, whereas Baran discloses both sponge-like material U and external cuff D. For these reasons, contrary to the Examiner's position, external cuff D is not a sponge coating. Applicants respectfully note that the Examiner did not respond to Applicants' argument concerning the sponge coating presented in Applicants' Amendment dated May 21, 2007.

Thus, Baran does not disclose, teach, or suggest each and every element of independent claim 14. Therefore, Applicants respectfully submit that the rejection of claim 14 should be withdrawn. Because dependent claims 15, 17, and 20-22 depend from

independent claim 14, the rejection of claims 15, 17, and 20-22 should be withdrawn for at least the same reasons that the rejection of claim 14 should be withdrawn.

Rejections Under Section 103(a)

Claim 16 is rejected under Section 102(b) as anticipated by, or in the alternative, under Section 103(a) as obvious over Baran. This rejection is respectfully traversed.

As discussed above, Baran does not disclose each and every element of independent claim 14; in particular, Baran fails to disclose, teach, or suggest a “reservoir space” or a “sponge coating.” There is no teaching, suggestion, or motivation to modify Baran to contain a reservoir space or a sponge coating. With respect to the reservoir space, it would not be obvious to modify the device of Baran to put a reservoir space between sponge-like material U (the element the Examiner calls the membrane) and internal cuff E (the element the examiner calls the balloon). Sponge-like material U would absorb any anesthetic added to the reservoir space, and therefore the reservoir space would serve no purpose. With respect to the sponge coating, it would not be obvious to put a sponge coating on the outside of the device of Baran. There is no teaching, suggestion, or motivation to have a sponge coating outside external cuff D, and it would not be obvious to modify external cuff D to be a sponge coating, because that would effectively remove external cuff D and make external cuff D part of sponge-like material U. Baran teaches having both sponge-like material U and external cuff D, where the sponge-like material U is compressed against external cuff D in order to force the anesthesia through external cuff D to the target. (Col. 2, lines 23-27; col. 3, lines 16-27.) If external cuff D is removed, the device of Baran would not operate as intended.

Thus, independent claim 14 is not obvious to one of ordinary skill in the art over Baran. Because claim 16 depends from independent claim 14, the rejection of claim 16 should be withdrawn for at least the same reasons that Baran does not render claim 14 obvious.

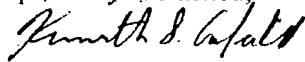
Claim 16 recites that “the void space of the sponge coating is greater than about 60% of the volume of the sponge coating.” Because Baran does not disclose, teach, or suggest a sponge coating and it would not be obvious to modify Baran to have a sponge coating, the recited percentage of void space is also not disclosed or suggested by Baran. Additionally, and only for the sake of argument, even if external cuff D were a sponge coating and the perforations at M were voids, Baran still discloses no percentage of perforation space relative to volume of external cuff. Therefore, the rejection of claim 16 should be withdrawn for this additional reason.

CONCLUSION

It is believed that claims 14-17 and 20-22 are in condition for allowance. Should the Examiner not agree with any of Applicants' positions or arguments herein, a telephonic or personal interview is respectfully requested to discuss and resolve any remaining issues.

An RCE is filed herewith. Aside from fee for the RCE, no fee is believed due for this response. Should any fee(s) be due at this time, please charge such fee(s) to Jones Day Deposit Acct. No. 50-3013.

Respectfully submitted,



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Kenneth S. Canfield (Reg No.) 58,442
For: Gidon D. Stern (Reg. No.) 27,469
JONES DAY
222 East 41st Street
New York, New York 10017
(212) 326-3939